

utilized type of LED integrated button for activation, deactivation & event notification claimed functions for the design choice substitution without having any differences in terms of performing/supporting or teaching the claimed combination limitations.

- d. On pages 12-13, as for the claims 41 & 45-46, the above discussions (e.g., paragraph 2a-2c are similarly applied.
- e. The examiner suggests the applicant to carefully review all of the Examiner cited references before responding to this office action. The examiner relies on the cited art for the well known prior art/common knowledge/support of the official notice.
- f. In summary, the examiner believes that the arguments between the applicant and the examiner caused by the difference in the interpretations of the present claims & the teachings of the cited references. Therefore, the examiner suggests the applicant carefully consider the possible , more broad, interpretations that can be applied to the claims and the teachings of cited references.

The Claim Rejections Under 35 U.S.C. §102

Claims 18-20 and 42-44 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 5,552,967 to Seto et al. (hereinafter, "Seto").

Applicant respectfully submits that the subject matter recited in each of the claims discussed below is patentably distinct from Seto, as will become apparent.

Claim 18, previously amended, recites a portable handheld computing device comprising:

- a casing having upper and lower surfaces, opposing front and back side surfaces, and opposing end surfaces, the ends being dimensionally shorter than the front and back side surfaces; and
- a light emitting device mounted externally on the casing, the light emitting device being positioned on the upper surface and wrapping around to and being raised on one of the end surfaces, the light emitting device being activated upon occurrence of an event to notify a user.

1 The Office, in its response to Applicant's arguments, writes in paragraph 2a
2 of the present Action that the front wall 8a and the top wall 8b of section 8 can be
3 interpreted to disclose the upper surface and the end surface recited in claim 18.
4 Following this assumption, the Office then writes that "the teachings of the Seto
5 [reference] anticipates [sic]... the present claimed invention." (Present Action,
6 paragraph 2a.) The Office also reiterates its rejection from a prior Action in
7 paragraph 5, which will be addressed later below.

8 First, even if the Office carves up the housing 4 of Seto to make section 8 a
9 stand-alone device, the resulting device does not teach or disclose the upper
10 surface and end surfaces of claim 18. The Office interprets section 8 such that the
11 front wall 8a teaches the upper surface of claim 18 and the top wall 8b teaches the
12 end surfaces of claim 18. But neither the front wall 8a nor the top wall 8b teach or
13 disclose "a casing having upper and lower surfaces, opposing front and back side
14 surfaces, and opposing end surfaces, the ends being dimensionally shorter than the
15 front and back side surfaces", as required by claim 18. As is clearly shown in Fig.
16 1 of Seto, the top wall 8b of section 8 is not dimensionally shorter than anything
17 approximating a front and back side surface of section 8.

18 Second, the Office continues to rely on this interpretation, writing that
19 Figure 1 of Seto teaches a raised LED. (*See Seto*, paragraph 2a). Again, even if
20 the Office carves up the housing 4 of Figure 1 in an attempt to show the claimed
21 invention, the resulting device does not teach or disclose a light emitting device
22 being positioned on the upper surface and wrapping around to and being raised on
23 one of the end surfaces, as required by claim 18. Rather, Seto discloses in Figure
24 7 that the indicator 254 is flush with the front wall 8a and the top wall 8b of
25 section 8. (*See Seto*, Fig. 7). Following the Office's interpretation of the front

1 wall 8a and the top wall 8b teaching the upper surface and an end surface, the
2 indicator 254 shown is flush with the front wall 8a and the top wall 8b. It cannot,
3 therefore, also be "raised on one of the end surfaces", as required by claim 18.

4 The Office, in reiterating various claim rejections from a prior Action,
5 continues to argue that feature (254) shown in Figure 1 of Seto teaches a "light
6 emitting device (LED) mounted externally on the casing, the LED being
7 positioned on the upper surface and wrapping around to and being raised on one of
8 the end surfaces". (Paragraph 5 of present Action). Applicant continues to
9 disagree.

10 The cited indicator 254 of Seto is not positioned on an upper surface and
11 wrapping around an end surface. The cited indicator 254 is located at a meeting
12 point of a front wall 8a and a top wall 8b of a section 8. (See Seto, col. 23, lines
13 57-68, col. 10, lines 38-44, and Fig. 1). These walls, rather than wrapping to an
14 end surface, are integral with a top cover 6, as shown in Figs. 1, 7 and 8. (See also
15 Seto at col. 23, lines 57-68 and col. 10, lines 41-44). In sum, the cited indicator
16 254 simply does not wrap around to or even contact an end surface.

17 Also, as written above, the cited indicator 254 of Seto is not raised on an
18 end surface; Seto discloses the indicator 254 as flush with the front wall 8a and the
19 top wall 8b of section 8. (See *Supra*).

20 Thus, the apparatus cited by the Office does not disclose a light emitting
21 device being positioned on the upper surface and *wrapping around to and being*
22 *raised on one of the end surfaces*, as claim 18 requires.

23 Claim 19, previously amended, recites a portable handheld computing
24 device comprising:
25

- a casing having a base and a lid; and
- a light emitting device mounted externally and raised on the lid, the light emitting device being activated upon occurrence of an event to notify a user.

The Office, in its response to Applicant's arguments, writes in paragraph 2b of the present Action that its argument of paragraph 2a is similarly applied for claims 19-20 and 42-44. (*See Present Action*, paragraph 2b). The Office also reiterates its rejection from a prior Action in paragraph 5, which will be addressed later below.

As written above, Seto, using the Office's current interpretation or otherwise, does not teach or disclose "a light emitting device mounted externally and raised on the lid", as required by claim 19. (*See Supra*).

Also, in reiterating various claim rejections from a prior Action, the Office argues that feature (254) of Figure 1 of Seto, along with features shown in Figures 1 and 8 of Seto, anticipate claim 19. (Paragraph 5 of present Action). Applicant continues to disagree.

First, the indicator 254 cited by the Office is in the housing 4 of the base unit 2, shown in Figure 1 of Seto. But the base unit 2 is not a lid. (*See Seto*, Figure 1). Seto teaches "a display unit 3 ... hinged to the base unit 2", which is arguably a lid. (*See Seto*, Figure 1 and col. 10, lines 18-20). The indicator 254 relied on by the Office, however, is not in the display unit 3—it is in the base unit 2. Thus, Seto fails to disclose a light emitting device mounted on a lid.

Second, the indicator 254 cited by the Office is not "raised". As shown above, Seto teaches that the indicator 254 is flush with its surrounding surfaces. (*See supra*).

1 Thus, the apparatus cited by the Office does not disclose a light emitting
2 device *mounted externally and raised on the lid*, as required by claim 19.

3 Claim 20, previously amended, recites a portable handheld computing
4 device comprising:

- 5
- 6 • a casing having a base and a lid that opens and closes relative to the
7 base, the lid having an upper surface, opposing side surfaces, and
8 opposing end surfaces; and
- 9 • a light emitting device mounted externally on the casing, the light
10 emitting device being activated upon occurrence of an event to
11 notify a user, positioned on the upper surface of the lid, and
12 wrapping around to one of the end surfaces so that the light emitting
13 device is visible from both opposing side surfaces and both opposing
14 end surfaces when the lid is opened or closed.

15 The Office, in its response to Applicant's arguments, writes in paragraph 2b
16 of the present Action that its argument of paragraph 2a is similarly applied for
17 claims 19-20 and 42-44. (*See Present Action*, paragraph 2b). The Office also
18 reiterates its rejection from a prior Action in paragraph 5.

19 As written above, Seto, using the Office's current interpretation or
20 otherwise, does not teach or disclose a "light emitting device... positioned on the
21 upper surface of the lid", as required by claim 20. (*See Supra*).

22 Also as written above, Seto does not disclose a "light emitting device...
23 positioned on the upper surface... and wrapping around to one of the end
24 surfaces", as required by claim 20. (*See Supra*).

25 In reiterating various claim rejections from the prior Action, the Office
argues that Figures 1 and 8 (presumably with the feature (254)) of Seto disclose an
LED "positioned on the upper surface of the lid, and wrapping around to one of

1 the end surfaces so that the LED is visible from both opposing side surfaces and
2 both opposing end surfaces when the lid is opened or closed." (Paragraph 5 of
3 present Action). Applicant continues to disagree for the reasons above and also
4 for those below.

5 Seto fails to disclose an LED that is "visible from both opposing side
6 surfaces and both opposing end surfaces when the lid is opened or closed." Seto,
7 rather, teaches that the indicator (254), as shown in Figures 1 and 8, is not visible
8 from end surfaces when the display 3 is closed or from any side surface, whether
9 the display 3 is open or closed. (See Seto, Figures 1 and 8).

10 Thus, the apparatus cited by the Office does not disclose "a light emitting
11 device ... positioned on the upper surface of the lid, and wrapping around to one
12 of the end surfaces so that the light emitting device is visible from both opposing
13 side surfaces and both opposing end surfaces when the lid is opened or closed", as
14 required by claim 20.

15 Claim 42, previously added, recites a portable handheld computing device
16 comprising:

- 17
- 18 • a casing having upper and lower surfaces, front and back side
surfaces, and opposing end surfaces; and
 - 19 • a light emitting device mounted externally on the casing,
 - 20 • wherein the light emitting device is:
 - 21 • activated upon occurrence of an event to notify a user; and
 - 22 • positioned such that the light emitting device is visible from the
upper surface, one of the side surfaces, and one of the end surfaces.
- 23
24
25

1 Claim 42 recites a light emitting device positioned such that "the light
2 emitting device is visible from the upper surface, one of the side surfaces, and one
3 of the end surfaces".

4 The claimed light emitting device performs differently than the indicator
5 (254) disclosed by Seto. As is clear from Figures 1 and 8, Seto does not disclose a
6 light emitting device that performs the function of being "visible from ... one of
7 the side surfaces, and one of the end surfaces". (See Seto, Figures 1 and 8). The
8 indicator (254) of Seto, rather, teaches an LED visible, when the display unit 3 is
9 open, by a viewer looking in a direction perpendicular to a side wall 5b that is
10 furthest from the open display unit 3. (See Seto, col. 10, lines 28-37 and Figure 1).
11 Seto simply does not disclose that the indicator (254) is visible from any of the
12 other three side walls 5b. (*Id.*). Further, when the display unit 3 is closed, the
13 indicator (254) is not visible when viewed from a direction perpendicular to any of
14 the side walls 5b. (*Id.*). Thus, the claimed light emitting device performs
15 differently than the apparatus disclosed in Seto.

16 **Dependent claims 43-44**, previously added, depend from claim 42 and are
17 allowable as depending from an allowable base claim. These claims are also
18 allowable for their own recited features that, in combination with those recited in
19 claim 42, are neither disclosed nor suggested in references of record, either singly
20 or in combination with one another.

21
22 **The Claim Rejections Under 35 U.S.C. §103(a)**

23 **Claims 23, 41, and 45-46** stand rejected under 35 U.S.C. §103(a) as being
24 unpatentable over Seto in view of U.S. Patent No. 6,041,215 to Maddrell et al.
25 (hereinafter, "Maddrell"), U.S. Patent No. 4,056,701 to Weber (hereinafter,

1 "Weber"), U.S. Patent No. 4,454,596 to Wunsch et al. (hereinafter, "Wunsch"), or
2 U.S. Patent No. 5,606,712 to Hidaka (hereinafter, "Hidaka").

3 The Office admits differences between what Seto discloses and what the
4 claims recite, stating that these differences are "Design Choice" matters. In
5 support of this rejection, the Office takes official notice on design choice matters
6 for off-button integration and light-emitting device and button combinations, as
7 well as the physical situations of the LED. The Office writes that Maddrell,
8 Weber, Wunsch, and Hidaka demonstrate these design choices.

9 Dependent claim 23, previously amended, depends from claim 18 and is
10 allowable as depending from an allowable base claim. This claim is also
11 allowable for its own recited features that, in combination with those recited in
12 claim 18, are neither disclosed nor suggested in references of record, either singly
13 or in combination with one another.

14 The Office, in its response to Applicant's arguments, writes in paragraph 2c
15 of the present Action that the secondary references of Weber, Wunsch, and
16 Maddrell describe "commonly utilized type of LED integrated button for
17 activation, deactivation & event notification claimed functions for the design
18 choice substitution without having any differences in terms of
19 performing/supporting or teaching the claimed combination limitations." This
20 response does not, however, address the deficiencies in the Office's rejection of
21 claim 18, on which claim 23 depends.

22 The Office also reiterates its attempt to establish well-known prior art,
23 writing that "the shape, size, and location of such LED is clearly within the choice
24 of the designer, as supported by the examiner cited prior art of record and more
25

1 not yet cited but the examiner would like [to] give official notice on such well
2 known design choices.” (Present Action, paragraph 3).

3 Rejection of claims as a “design choice” matter are appropriate when a
4 change in an element’s size or proportion “would not perform differently than the
5 prior art device.” (M.P.E.P. §2144.04(IV)(A), citing *Gardner v. TEC Systems,*
6 *Inc.* 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 830,
7 225 USPQ 232 (1984)).

8 Design-choice rejections are not appropriate, however, when a claimed
9 structure and the function it performs are different from the prior art. *See In re*
10 *Gal*, 980 F.2d 717, 25 USPQ2d 1076 (Fed. Cir. 1992) (finding of “obvious design
11 choice” precluded where the claimed structure and the function it performs are
12 different from the prior art).

13 Specifically, Weber and Wunsch fail to teach or disclose a “light emitting
14 device being positioned on the upper surface and wrapping around to and being
15 raised on one of the end surfaces”, as required by claim 18 on which claim 23
16 depends. Instead, Weber discloses a “low profile, lighted, push button switch”
17 shown mounted such that it does not wrap around an end surface. (*See Weber*,
18 *Fig. 4 and Abstract*). And, Wunsch discloses “lighted push buttons... mounted on
19 a board” that do not wrap around an end surface. (*See Wunsch*, *Figs. 1, 2, 3a, 3b,*
20 *5, 13, and 14; and abstract*).

21 Likewise, Maddrell fails to teach or disclose a “light emitting device being
22 positioned on the upper surface and wrapping around to and being raised on one of
23 the end surfaces”, as required by claim 18 on which claim 23 depends. Instead,
24 Maddrell discloses a visual indicia flush with a single surface. (*See Maddrell*,
25 *Figs. 1, 7, and 19; and abstract*).

1 Finally, Hidaka fails to teach or disclose a "light emitting device being
2 positioned on the upper surface and wrapping around to and being raised on one of
3 the end surfaces", as required by claim 18 on which claim 23 depends. Instead,
4 Hidaka discloses an "LED cover 18... provided at one side edge portion of the
5 cover 2", showing that the device of Hidaka is flush with a surface, rather than
6 being raised. (*See Hidaka*, column 5, lines 29-31 and 55-59 and Fig. 1).

7 In sum, these references do not provide the deficiencies of Seto. They do
8 not teach or disclose a "light emitting device being positioned on the upper surface
9 and wrapping around to and being raised on one of the end surfaces", as required
10 by claim 18. They do not teach or disclose the claimed structure or function, as
11 required by *In re Gal*. They do not teach or disclose a device that, with a changed
12 size or proportion, would cause the device to perform as the claimed structure
13 performs, as required by *Gardner*.

14 **Dependent claim 41**, previously added, is allowable at least by virtue of its
15 dependency on dependent claim 23 and base claim 18. This claim is also allowable
16 for its own recited features that, in combination with those recited in claims 18 and
17 23, are neither disclosed nor suggested in references of record, either singly or in
18 combination with one another.

19 **Dependent claims 45-46**, previously added, depend from claim 42 and are
20 allowable as depending from an allowable base claim. These claims are also
21 allowable for their own recited features that, in combination with those recited in
22 claim 42, are neither disclosed nor suggested in references of record, either singly
23 or in combination with one another.

24 Further, the Office admits that Seto "does not expressly disclose ... the
25 physical situations of the LED". (Paragraph 7 of present Action). To address this

1 deficiency, the Office states that "such difference in limitation is a design choice
2 matter to one having ordinary skill in the art", taking "official notice on such
3 design choice matter as off button integration." (*Id.*).

4 Applicant respectfully objects to and traverses the taking of official notice.
5 In accordance with M.P.E.P. §2144.03, Applicant requests that the Office produce
6 art teaching a light emitting device "further visible from the bottom surface" or
7 "further visible from the bottom surface, another end surface, and another side
8 surface" in relation to a light emitting device being activated upon occurrence of
9 an event to notify a user. The Office refers to Weber, Wunsch, Maddrell, and
10 Hidaka, but has not shown that these references teach a light emitting device
11 "positioned such that the light emitting device is visible from the upper surface,
12 one of the side surfaces, and one of the end surfaces" and "wherein the light
13 emitting device is further visible from the bottom surface" or "wherein the light
14 emitting device is further visible from the bottom surface, another end surface, and
15 another side surface."

CONCLUSION

All pending claims 18-20, 23, and 41-46 are in condition for allowance.
Applicant respectfully requests reconsideration and prompt issuance of the subject application.

Respectfully Submitted,

Dated: 2 APR 04

By:

Michael K. Colby
Michael K. Colby
Reg. No. 45,816
(509) 324-9256 ext. 240